

### REMARKS

Claims 1-26 are pending in the present application. Reconsideration of the claims is respectfully requested.

#### **I. Interview**

Applicants thank the Examiner for the courtesy of an interview on February 5, 2004. Applicant argued that Khan et al. does not teach identifying a payment amount to insure delivery based on network characteristics of a network in which the electronic document is to be transmitted to form an identified payment amount. The Examiner agrees that Khan does not teach this feature. The Examiner indicated that he will reconsider the rejection upon further search and consideration.

#### **II. 35 U.S.C. § 103, Alleged Obviousness, Claims 1-26**

The Office Action rejects claims 1-26 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Khan et al. (U.S. Patent No. 6,199,054 B1). This rejection is respectfully traversed.

As to claims 1-26, the Office Action states:

Khan et al. teaches automated software metering of digital payloads that dynamically computes and/or assesses the costs associated with Internet based content delivery (column 2; lines 20-22). Khan et al. teaches a cost metering system with similarities to the U.S. postal service (column 2; lines 35-36) where computed billing information is dynamically updated visually as the user adds or removes items to and from the payload to be transmitted (column 2; lines 30-34). Khan et al. further teaches the costs determined based on the type of service provided and payment received based on a credit card charge (column 2; lines 35-43).

Examiner notes that a user opening this digital payload envelope and selecting services is the same as Applicants receiving a request from a requestor for delivery of an electronic document. The bitmapped stamp of Khan et al. represents receiving the request, identifying a payment amount based on network characteristics and sending acknowledgement to

requestor, where acknowledgement includes payment amount. Examiner further notes that the user selecting send, is interpreted as sending the electronic document in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount.

Examiner takes official notice that it is old and well known for the post office to offer the option for users to purchase insurance when sending an item. The insurance is based on the value of the item being delivered and guarantees on-time delivery of the items. Insurance is used in order to provide the customer with a sense of security that their item will be delivered on time.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Khan et al. by altering the time stamping service (column 5; line 3) and the quality of service box (Figure 2; 1009) to allow users to purchase insurance, as taught by Official Notice, when selecting the quality of service they desire. The cost for this service would be identified based on the same network characteristics as the regular delivery and added to the payload envelope for user approval/acknowledgement. If a user were to select this option and the item was not delivered on time the user would get a refund of his/her money plus compensation for the value of the document as taught by Official Notice. One of ordinary skill in the art at the time of the invention would be motivated to combine these references in order to provide users with a sense of security that their item will be delivered on time.

Office Action dated November 7, 2003, pages 2-3.

Claim 1, which is representative of the other rejected independent claims 13, 15, and 25 with regard to similarly recited subject matter, reads as follows:

1. A method in a data processing system for insuring delivery of an electronic document, the method comprising:
  - receiving a request from a requestor to insure delivery of the electronic document;
  - responsive to receiving the request, identifying a payment amount to insure delivery based on network characteristics of a network in which the electronic document is to be transmitted to form an identified payment amount;
  - sending an acknowledgment of the electronic document to the requestor, wherein the acknowledgment includes the identified payment amount; and
  - delivering the electronic document in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount.

Khan does not teach or suggest identifying a payment amount to insure delivery based on network characteristics of a network in which the electronic document is to be transmitted to form an identified payment amount. Khan is directed to a system that monitors data payload, which is being transmitted in a secure form over the Internet, and provides rate computations for such payloads based on the size of the data. In the Khan system, each data payload is incorporated into a data container that may be implemented as a digital envelope with the bitmap of a stamp. The current rate for the data container is shown on the stamp and is dynamically updated as data files are added to the envelope. The overall cost is a function of the applied rate card, the size of the data and the type of security services provided.

Thus, with the system of Khan, the cost, which is associated with each data container, is based upon the size of the document, type of document, the type of compression used on the contents, the type of encryption provided for securing the document urgency of the delivery, the type of services the user subscribes to and is using in a communication. Khan does not teach or suggest identifying a payment amount to insure delivery based on network characteristics of a network in which the electronic document is to be transmitted to form an identified payment amount. The Office Action alleged that this feature is taught by Khan at column 2, lines 20-38, which reads as follows:

The present invention provides a system and method for dynamically computing and/or assessing costs associated with Internet based content delivery. The content to be delivered can be any kind of electronic document or compound document that may contain various kinds of data, including multimedia data. The costs can be based upon the type of security services provided by the institution or the Internet Service Provider (ISP). The present invention provides the service provider the flexibility to customize their billing rules, and to provide billing rules that are fair to their end users in specific market segments. Computed billing information is dynamically updated visually as the user adds or removes items (content) to and from the payload to be transmitted. This visual update can be presented in several ways to the user.

A preferred embodiment utilizes a cost metering system that has some similarities to the one used by the U.S. postal service, where a weighting apparatus updates a display that shows the postal charges.

In this section, Khan is merely describing that the costs associated with electronically mailing a data container, consisting of a data payload, is based upon the size of the document and the type of encryption provided for securing the document urgency of the delivery. Nowhere in this section, or any other section of Khan, is it taught or suggested that the cost for electronically mailing a data container, containing a data payload, is calculated based on network characteristics of a network in which the electronic document is to be transmitted which may include congestion on a network, network traffic characteristics, reliability of the network, and transmissions statistics for the network.

In addition, the combination of Khan with the Examiner's Official Notice that it is old and well known for the post office to offer the option for users to purchase insurance when sending an item. The insurance is based on the value of the item being delivered and guarantees on-time delivery of the items. The old and well-known services available from the United States Post Service (USPS) do not provide for the deficiencies of Khan. That is the USPS does not identify a payment amount to insure delivery based on network characteristics of a network in which an electronic document is to be transmitted.

Moreover, there is no suggestion in either the Khan reference or the services of the USPS to modify the references and services to include such features. That is, there is no teaching or suggestion in Khan or the USPS that a problem exists for which identifying a payment amount to insure delivery based on network characteristics of a network in which an electronic document is to be transmitted is a solution. To the contrary, Khan merely teaches charging based upon the size of the document, type of document, the type of compression used on the contents, the type of encryption provided for securing the document urgency of the delivery, the type of services the user subscribes to and is using in a communication. The USPS does not identify a payment amount for a given delivery based on the congestion of the airways or traffic accidents that may delay trucks.

One of ordinary skill in the art, being presented only with Khan and the USPS and without having prior knowledge of Applicants' claimed invention, would not have found it obvious to combine and modify Khan and the USPS to arrive at Applicants' claimed invention. To the contrary, even if one were somehow motivated to combine Khan and

the USPS, and it were somehow possible to combine the two systems, the result would not be the invention as recited in claim 1. The result would be an insured delivery of a electronic document based on based upon the size of the document, type of document, the type of compression used on the contents, the type of encryption provided for securing the document urgency of the delivery, and/or the type of services the user subscribes to and is using in a communication.

In view of the above, Applicants respectfully submit that neither Khan nor the USPS, either alone or in combination, teach or suggest all of the features of claims 1, 13, 15 and 25. At least by virtue of their dependency on claims 1 and 15, neither Khan nor the USPS, either alone or in combination, teach or suggest the features of dependent claims 2-7 and 16-21. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-7, 13, 15-21 and 25 under 35 U.S.C. § 103(a).

Moreover, in addition to their dependency from independent claims 1 and 15, respectively, neither Khan nor the USPS, either alone or in combination, teach or suggest the specific features recited in claims 2-7 and 16-21. For example, with regard to claims 4, 5, 18 and 19, Khan does not teach or suggest identifying a payment amount based on a value of the electronic document in addition to the network characteristics and that identified value of the electronic document is received from the requestor. The Office Action fails to provide a section of Khan where this feature is taught. However, as shown above, Khan is only concerned with costs based upon based upon the size of the document, type of document, the type of compression used on the contents, the type of encryption provided for securing the document urgency of the delivery, the type of services the user subscribes to and is using in a communication. The USPS does not make up for the deficiencies of Khan. Thus, neither Khan nor the USPS, either alone or in combination, teach or suggest the specific features of dependent claims 4, 5, 18 and 19.

As an additional example, with regard to claims 6 and 20, neither Khan nor the USPS teach or suggest identifying a payment based on network characteristics where the network characteristics include congestion on a network, network traffic characteristics, reliability of the network, and transmissions statistics for the network. As shown above, Khan is only concerned with costs based upon based upon the size of the document, type of document, the type of compression used on the contents, the type of encryption

provided for securing the document urgency of the delivery, and/or the type of services the user subscribes to and is using in a communication. The USPS does not identify a payment amount for a given delivery based on the congestion of the airways or traffic accidents that may delay trucks. Thus, neither Khan nor the USPS, either alone or in combination, teach or suggest the specific features of dependent claims 6 and 20.

As a further example, with regard to claims 7 and 21, neither Khan nor the USPS teach or suggest sending a payment to requestor in response to an inability to deliver the electronic document within a time guaranteed. Nowhere, in any section of Khan, is it taught or suggested that the user would be reimbursed if an electronic document could not be delivered. The Examiner's Official Notice that it is old and well known for the post office to offer the option for users to purchase insurance when sending an item does not make up for the deficiencies of the Khan reference. The USPS is primarily concerned with shipping physical mail and packages. Thus, there would be no motivation to combine Khan with the USPS, as there is provision in the Khan system for delivering physical mail and packages. Delivering electronic documents presents vastly different problems than those associated with physical mail and packages. Therefore, a person of ordinary skill in the art would not look to the USPS to solve the deficiencies of Khan.

Therefore, in addition to being dependent on independent claims 1 and 15 respectively, dependent claims 2-7 and 16-21 are also distinguishable over Khan by virtue of the specific features recited in these claims. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-7 and 16-21 under 35 U.S.C. § 103(a).

With regard to independent claim 8, neither Khan nor the USPS, either alone or in combination, teach or suggest receiving a delivery status of the electronic document, determining from the delivery status if the electronic document has been timely delivered and compensating the requestor if the electronic document has not been timely delivered. Nowhere, in any section of Khan, is it taught that a status of the electronic mail is provided. In fact, Khan teaches that, once the data container is sent, the next step is to bill the user for the costs associated with the data container being sent. Khan simply does not address the issue as to providing a status as to the delivery of the data container nor, as shown above, does Khan teach or suggest that the user would be reimbursed if an

electronic document could not be delivered. Combining the Kahn reference with the USPS would not provide for the deficiencies of Khan and, consequently, does not provide a status of the delivery or a system to reimburse the user.

With regard to independent claims 9, 14, 22 and 26, neither Khan nor the USPS, either alone or in combination, teach or suggest providing insurance in response to the indication, wherein the payment is based on at least one of network traffic characteristics, network congestion, reliability properties of the network, value of the electronic document, and statistical transmittives. As shown above, Khan teaches the cost associated with mailing a data container is based on the size of the document, type of document, the type of compression used on the contents, the type of encryption provided for securing the document urgency of the delivery, and/or the type of services the user subscribes to and is using in a communication. The USPS does not identify a payment amount for a given delivery based on the congestion of the airways or traffic accidents that may delay trucks.

With regard to independent claim 12, neither Khan nor the USPS, either alone or in combination, teach or suggest providing insurance in response to the indication of a payment for insurance for a timely delivery of the electronic document using a network, where the payment is based on at least a number of times a party to whom insurance is being provided has been paid insurance proceeds for untimely delivery of electronic documents. As shown above, Khan does not provide costs based upon insurance for a timely delivery of the electronic document. While the USPS may provide insurance for delivery of physical mail and packages, the USPS does not base the payment on at least a number of times a party to whom insurance is being provided has been paid insurance proceeds for untimely delivery of electronic documents.

In view of the above, Applicants respectfully submit that neither Khan nor the USPS, either alone or in combination, teach or suggest all of the features of independent claims 8, 9, 12, 14, 22 and 26. At least by virtue of their dependency on independent claims 9 and 22, neither Khan nor the USPS, either alone or in combination, teach or suggest the features of dependent claims 10, 11, 23 and 24. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 8-12, 14, 22-24 and 26 under 35 U.S.C. § 103(a).

**III. Conclusion**

It is respectfully urged that the subject application is patentable over Khan and the Examiner's Official Notice and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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Francis Lammes

Francis Lammes  
Reg. No. P-55,353  
Carstens, Yee & Cahoon, LLP  
P.O. Box 802334  
Dallas, TX 75380  
(972) 367-2001  
Agent for Applicants

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